

## REMARKS

Claims 1-12 are pending in the application. Claims 1, 4, and 5 are currently amended. Reconsideration and allowance of claims 1-12 is respectfully requested in light of the foregoing amendments and the following remarks.

### Rejections under 35 U.S.C. §103

Claims 1, 5, and 7-10 stand rejected under §103(a) as being anticipated by U.S. Patent No. 5,368,954 to Bruns ("Bruns") in view of U.S. Patent No. 5,643,297 to Nordgren et al. ("Nordgren"). As the PTO provides in MPEP §2143, "[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Neither of the cited references teach the claimed limitations. Claims 1 and 5, as amended, teach the use of a sterile package containing or comprising a single use, disposable battery pack. Neither of the references teach, nor would it be obvious in light of the references to use, sterilized, single use, disposable batteries. The non-obvious benefits of single use, disposable batteries in the present configuration are enumerated in the specification and include "higher energy capacity per volume," "higher energy capacity per weight," "higher reliability," and "may be entered into the normal waste stream." Neither of the cited references, nor the combination, suggest the desirability of using single use, disposable batteries. In fact, Bruns specifically teaches away from the claimed invention, preferring rechargeable batteries (col. 3, line 7), in direct contradiction to the claimed invention.

Furthermore, combining of the references is improper. MPEP §2142 provides, ". . . the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made . . . . [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." Here, Nordgren et al. describes a pre-sterilized, self-contained instrument which includes a battery (col. 17, lines 53-56; col. 5, lines 6-8). In Nordgren, the entire instrument is designed to be disposed of after a single use. Neither of the cited references even suggest the desirability of combining the fully integrated, self-powered, fully disposable instrument of Nordgren with the removable, rechargeable, and reusable coupled powered source described by Bruns. Any suggestion to combine references is provided

exclusively by the Applicant, and using the claimed invention as an instruction manual or template to piece together the teachings of the prior art is an improper hindsight reconstruction.

Claims 2, 3, 6, and 12 stand rejected under §103(a) as being anticipated by Bruns in view of Nordgren and further in view of admitted prior art. Claims 2 and 6 depend from and further limit claims 1 and 5, and therefore are in a condition for allowance. Claim 3 teaches the use of a sterile package containing a disposable battery. As described in the specification, disposable batteries are primary batteries as opposed to rechargeable batteries. Thus, the rejection of claim 3 is improper for the same reasons as described for claims 1 and 5.

Claims 4 and 11 stand rejected under §103(a) as being anticipated by Bruns. Claim 4, as amended, describes a single use, disposable battery pack, and for the same reasons as claims 1 and 5, is allowable. Claim 11 teaches the use of a disposable battery. As described in the specification, disposable batteries are primary batteries as opposed to rechargeable batteries. Thus the rejections of claim 11 and dependent claim 12 are improper for the same reasons as described for claims 1 and 5.

Conclusion

Therefore, it is respectfully submitted that independent claims 1, 3 -5, and 11 are in condition for allowance. Claims 2, 6-10, and 12 depend from and further limit independent claims 1, 3-5, and 11 and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

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**Marked-up Claims Pursuant to CFR § 1.121**

1. (Amended) A surgical instrument comprising:
  - (a) a handpiece having a tool supporting end, and a battery receiving end;
  - (b) a sterile package comprising a single use, disposable battery pack having an attachment end;
  - (c) one of the battery receiving end and attachment end having an alignment post with a plurality of electrical contacts arranged concentric thereto, and the other thereof having a central opening defining a longitudinal axis with a set of electrical contact elements concentric to that axis; and
  - (d) wherein the two sets of contacts are adapted to become lockingly and conductively interengaged upon engagement of the alignment post with the central opening and in response to rotation of the battery pack relative to the handpiece.
  
4. (Amended) A surgical instrument comprising:
  - (a) a handpiece having a tool supporting end, and a battery receiving end with an alignment post extending therefrom, the battery receiving end of the handpiece also having a set of electrical contact elements arranged in generally concentric relation to the alignment post;
  - (b) a single use, disposable battery pack having an attachment end with a central opening therein, and a set of mating electrical contact elements arranged in a generally circular configuration concentric to the central opening;
  - (c) the sets of mating contacts being adapted to come into a mutually concentric relation in response to insertion of the alignment post into the central opening;
  - (d) the sets of contacts upon rotation of the battery pack relative to the handpiece being adapted to then become lockingly and conductively interengaged in a predetermined relative position; and
  - (e) means indicating by at least one of sight, sound, and touch that the predetermined relative position has been achieved.
  
5. (Amended) A surgical instrument for performing a cutting, shaping, or drilling operation on bone or hard tissue, comprising:

- (a) a handpiece having a battery receiving end with an alignment post extending therefrom;
- (b) a sterile package containing a single use, disposable battery pack which has an attachment end with a central opening therein;
- (c) the central opening in the single use, disposable battery pack being adapted to insertably receive the alignment post so as to establish a mutual alignment axis of handpiece and battery pack;
- (d) the battery receiving end of the handpiece and the attachment end of the single use, disposable battery pack having flat end surfaces adapted for abutting engagement while yet allowing relative rotation of the battery pack relative to the handpiece;
- (e) the battery receiving end of the handpiece and the attachment end of the single use, disposable battery pack having mating sets of electrical contact elements, each set being arranged generally concentric to the mutual alignment axis; and
- (f) wherein upon the insertion of the alignment post of the handpiece into the opening of the battery pack, the sets of mating contacts are adapted to then become lockingly and conductively interengaged in response to rotation of the battery pack relative to the handpiece.